



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,514	03/29/2002	Koji Yanai	2002_0451A	7814

7590 03/01/2006

Wenderoth Lind & Ponack
Suite 800
2033 K Street NW
Washington, DC 20006

EXAMINER

KAM, CHIH MIN

ART UNIT PAPER NUMBER

1656

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/089,514

Applicant(s)

YANAI ET AL.

Examiner

Chih-Min Kam

Art Unit

1656

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☒ Newly proposed or amended claim(s) 26-31 and 33-37 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 26-31 and 33-37.

Claim(s) objected to: 20.

Claim(s) rejected: 1,5-7,17,19,21 and 32.

Claim(s) withdrawn from consideration: 23 and 25.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: See Continuation Sheet.

Continuation of 5. Applicant's reply has overcome the following rejection(s): the rejection of claims 1, 5-7, 19-21, 33 and 35-37 under 35 USC 112, second paragraph; the rejection of claims 1, 5-7, 19-21, 26, 28, 30, 32, 33 and 35-37 under 35 USC 112, first paragraph, written description; the rejection of claims 20, 33 and 35-37 under 35 USC 112, first paragraph, scope of rejection; and the rejection of claims 26, 28 and 30 under 35 USC 102(b).

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1, 5-7, 17, 19, 21 and 32 are rejected under 35 U.S.C. § 112, first paragraph, scope of enablement; and claims 20 is objected to.

Continuation of 13. Other: In the amendment filed February 7, 2006, claims 1, 5, 26, 28, 30 and 33 have been amended. Applicant's response has been fully considered, however, claims 1, 5-7, 17, 19, 21 and 32 remain rejected under 35 U.S.C. § 112, first paragraph, scope of enablement, because the specification, while being enabling for transformants of *Mycelia sterilia* containing genes encoding SEQ ID NOS: 2, 4, and 6 that make para-substituted PF1022 wherein the substitution is a -NO₂ or -NH₂ functional group on the benzene ring, does not reasonably provide enablement for any transformant to make a peptide or depsipeptide having a benzene ring substituted at para-position with a nitro or amino group using a polynucleotide encoding the amino acid sequence of SEQ ID NO:2, a polynucleotide encoding the amino acid sequence of SEQ ID NO:4, and a polynucleotide encoding the amino acid sequence of SEQ ID NO:6.

Applicants indicate that the claims have been amended to remove the "modifications" language, and thus, the claims are limited to the specific transformants of *Mycelia sterilia* containing genes encoding SEQ ID NOS: 2, 4, and 6 and the specifically disclosed metabolite, PF1022 and derivative thereof as defined by their chemical name and formulae. Therefore, the rejection should be withdrawn.

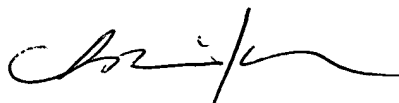
Applicants' response has been considered, however, the argument is not persuasive because the independent claim 1 is not only directed to transformants of *Mycelia sterilia* containing genes encoding SEQ ID NOS: 2, 4, and 6 to produce the specifically disclosed metabolite, PF1022 and derivative thereof, but also to the transformants of an unspecified microorganism containing polynucleotides encoding the amino acid sequences of SEQ ID NO:2, 4 and 6 to produce an unspecified metabolite (i.e., a peptide or depsipeptide) having a benzene ring substituted at para-position with a nitro or amino group, which requires undue experimentation to enable the full scope of the claims (See paragraph 13 of the Office Action dated 10/18/05).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner



CHIH-MIN KAM
PATENT EXAMINER

CMK
February 22, 2006